

Bruns ("Bruns") in view of other prior art. This 103(a) rejection precludes a final office action as it is a new ground of rejection necessitated neither by Applicant's amendment nor IDS. As such, the Applicant requests withdrawal of the finality of the February 6, 2003 Office Action.

Rejections under 35 U.S.C. §103

All of these remarks presume the acceptance of the amended claims recited in the Applicant's amendment mailed March 17, 2003. Claims 1-12 stand rejected under §103(a) as being anticipated by Bruns in view of either U.S. Patent No. 5,643,297 to Nordgren et al. ("Nordgren") and/or admitted art.

For example, independent claim 5 discloses "a sterile package containing a single use, disposable battery pack." As the PTO provides in MPEP §2143, "[t]o establish a prima facie case of obviousness, . . . there must be some suggestion or motivation . . . to combine the reference teachings, . . . [and] the prior art reference (or references when combined) must teach or suggest all the claim limitations." It is submitted that the Office Action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

First, neither Bruns nor Nordgren, nor the combination of the two teach "a sterile package containing a single use, disposable battery pack." As the Examiner has recognized, Bruns fails to disclose the use of a sterile package with a battery pack. As discussed in the telephone interview between the Examiner and the Applicant's attorney, sterility is of primary importance in a surgical setting, and thus the need for a sterile, single use, disposable battery pack is unique to the surgical field. The second reference, Nordgren, teaches disposing of the entire instrument, not the battery pack, after a single use. The surgical instrument of the Applicant's disclosure has the advantage of sterility, but unlike Nordgren, is far more economical because only the battery pack need be replaced.

Second, neither of the cited references suggest the desirability of combining the self-contained and entirely disposable instrument of Nordgren with the detachable pack and rechargeable batteries described by Bruns. Any suggestion to combine the references is based only on impermissible hindsight in light of the Applicant's disclosure. Indeed, each reference contains elements that teach away from the other. Nordgren discloses a self-contained instrument which teaches away from the detachable battery pack of Bruns. Similarly, Bruns teaches using rechargeable batteries which teaches away from the disposable instrument of Nordgren. Thus, because the combination of Bruns and Nordgren do not teach all of the claimed limitations and because there is no motivation to combine, it is respectfully submitted that claims 1, 2, and 5-10 are in a condition for allowance.


Claims 3, 4, 11, and 12 are in condition for allowance based upon the arguments cited in the Applicant's amendment mailed March 17, 2003.

Conclusion

Therefore, it is respectfully submitted that independent claims 1, 3 -5, and 11 are in condition for allowance. Claims 2, 6-10, and 12 depend from and further limit independent claims 1, 3-5, and 11 and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,



David M. O'Dell
Registration No. 42,044

Dated: 4-25-03
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972-739-8635
Facsimile: 972-680-7551

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